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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,587	09/27/2001	Sundar J. Rajan	54676US002	2684
32692	7590	01/28/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			CHEVALIER, ALICIA ANN	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1772	

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/937,587	RAJAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 November 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-36 is/are pending in the application.

4a) Of the above claim(s) 20-36 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> .	6) <input type="checkbox"/> Other: _____ .

**RESPONSE TO AMENDMENT**

1. Claims 1-36 are pending in the application, claims 20-36 are withdrawn from consideration due to Applicant's election, in paper #5 filed February 24, 2003 in response to the restriction in paper #3 mailed February 6, 2003.
2. Amendments to the specification, the addition of the abstract, in paper #8, filed on November 10, 2003, have been entered in the above-identified application.

***REJECTIONS REPEATED***

3. The 35 U.S.C. §102 rejection of claims 1-3 and 5-19 over Orensteen et al. (US Patent No. 5,508,105) is repeated for reasons previously made of record in paper #6, mailed May 6, 2003, pages 2-4, paragraph #4.

Orensteen discloses a signage article comprising a retroreflective core sheeting material with a surface binder layer of polyvinyl butyral or synthetic polyester (substrate comprising a noncellulosic organic polymeric surface) [col. 11, lines 3-24], a cured multi-function layer (a radiation cured coating disposed on the noncellulosic polymeric surface) [col. 11, line 63 to col. 12, line 7], and indicia formed from resin based colorant/binder (a marking material disposed on the radiation cured coating). See column 14, lines 31-48 and figure 3. The cured multi-function layer comprises an aliphatic acrylated urethane (e-beam/uv-curable composition) [col. 10, lines 14-49]. Furthermore, Orensteen does not disclose the need or use of a protective coating over the marking material [figure 3]. The signage article has use in validation stickers [col. 1, lines 51-57].

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It has been held that where claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively. Therefore, the *prime facie* case can be rebutted by *evidence* showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In the instant case, Orsensteen does not explicitly teach the properties wherein the marking material is not substantially removed from the signage article upon wiping the marking material with gasoline for five cycles, ten cycles, or twenty cycles, upon abrading the marking material for 1000 scrub cycles, or upon applying a pressure sensitive adhesive-coated tape to the marking material under thumb pressure and removing it. Also, Orsensteen does not explicitly teach the properties wherein the radiation cured coating is not substantially removed from the signage article upon wiping the marking material with gasoline for five cycles, upon abrading the marking material for 1000 scrub cycles, or upon applying a pressure sensitive adhesive-coated tape to the marking material under thumb pressure and removing it.

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Therefore, in addition to the above disclosed limitations, the presently claimed properties would have inherently been present because Orsensteen discloses the same materials used for the radiation cured coating (i.e. aliphatic acrylated urethane) and the marking material (i.e. resin based colorant/binder). MPEP 2112.01

4. The 35 U.S.C. §103 rejection of claim 4 as over Orensteen in view of Frank et al. (US Patent No. 5,153,618) is repeated for reasons previously made of record in paper #6, pages 4-5, paragraph #6.

Orensteen discloses all the limitations of the instant claimed invention except for the particular polymer in the resin-based colorant/binder.

Frank discloses a conventional two component marking indicia/toner comprising a resin and a colorant, where the resins include polyesters, vinyl resins etc. [col. 22, lines 12-48].

It would have been obvious to one of ordinary skill in the art at the time of the invention to use one of the resin listed in Frank as the resin in Orensteen's resin based colorant/binder because they are conventional resins used in two component indicia/toners.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

5. Applicant's arguments in paper #8 regarding the 35 U.S.C. §102 rejection over Orensteen of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Orensteen teaches away from cross-linking urethane/acrylic composition and therefore does not teach a radiation cured composition. Applicant correctly points out that Orensteen's composition "preferably does not contain a crosslinker" at column 10, lines 45-46. However, this passage does not exclude a crosslinker. Example 1 discloses that

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the different polyurethane compositions may have crosslinkers (col. 16, line 41). Example 1 further discloses that the coating is cured at room temperature followed by heating (col. 17, lines 16-17). Heat is a type of radiation, thus the composition is a radiation cured composition.

6. Applicant's arguments in paper #8 regarding the 35 U.S.C. §103 rejection over Orensteen in view of Frank of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Orensteen fails to teach a radiation cured coating and Frank fails to overcome the deficiencies of the Orensteen reference. Applicant's arguments regarding Orensteen have already been addressed above.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (571) 272-1498. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (571) 272-0987.

ac  
1/26/04



*Sandra M. Nolan*  
**SANDRA M. NOLAN**  
**PRIMARY EXAMINER**